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EXAMINER
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MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/996,077

Applicant(s)

GRAINGER, JEFFRY J.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on December 26, 2006, wherein:

Claims 1-17 are currently pending;

Claim 1 has been amended.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant has amended claims 1, 13, and 14 to incorporate the following limitation:

*tracking a time elapsed from receipt of the first signal indicating a request to submit a patent application for approval and a time elapsed from communicating said message requesting comments on said draft patent application from said second client system.*

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Upon reviewing applicant's original disclosure, the Examiner notes that applicant discloses:

[0053] The workflow design is defined in the customer set-up process. In the set-up process, users are assigned roles that play a part in the workflow. Rules are established that dictate to whom documents are routed at each stage in the process, how often users should be reminded of a task, and what task is required next after each preceding task. IP data processing system 100 has a mechanism for notifying users of required tasks, and for users to notify the system that tasks are complete. The system makes available (for example, through html links to documents stored in database 106) to the appropriate users any documents necessary for performing the relevant task (e.g., a maintenance fee due date reminder task sent to an appropriate in-house practitioner at a technology developer 110(x) may include an html link to the allowed patent so the practitioner can quickly review the patent's abstract and claims). In order to track and identify bottlenecks in the workflow process, ***the system automatically tracks the amount of total time elapsed since the beginning of the workflow, as well as the time elapsed during the performance of each task and the time elapsed between each task.*** The set-up process can be rerun at a later date to allow flexibility for changing roles or tasks, eliminating tasks, changing document routing, or otherwise redefining the workflow for any document at any time by authorized users.

Although, the Examiner submits, that applicant's specification discloses tracking the amount of total time elapsed since the beginning of the workflow, as well as the time elapsed during the performance of each task and the time elapsed between each task, the Examiner asserts that the disclosure does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of ***tracking a time elapsed from receipt of the first signal indicating a request to submit a patent application for approval and a time elapsed from communicating said message requesting comments on said draft patent application from said second client system,*** and thus this is new matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 11-14 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby (US 6,970,842) (hereinafter referred to as Ashby) in view of User's Guide for Microsoft Project for Windows 95 and Windows 3.1 published in 1995 (hereinafter referred to as Microsoft).

Referring to Claims 1, 13 and 14:

Ashby discloses a computer-implemented method and server system for managing documents related to a patent application, comprising:

**a server system (Figures 1a and 19 (10) comprising a processor (12), a database (26), a memory for storing a program (12) (14) and col. 3, lines 42-49);**

**storing a first workflow rule on a server system, wherein said first workflow rule causes, upon receipt of a first signal indicating a request for approval, the server system to generate a message that requests approval and route said message to a second client system based on routing information defined in the workflow rule (col. 3, line 42 thru col. 4, line 3 processor 12 coupled to a memory which contains a data structure 14 further comprising a plurality of software structures including control procedures, communications procedures and data; apparatus includes a notification structure that periodically distributes information to project**

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personnel base on predefined dates or activities, personnel may be notified by e-mail; client is notified of a request for approval; col. 4, lines 35-40 communication structure includes a notification structure 64 that distributes information to the users regarding certain tasks, accomplishments and upcoming date; col. 4, lines 41-44 certain personal are notified depending on their attributes such as position, group or access level, for example the client is notified of a request for approval; col. 4, lines 53-55 an approval structure 68 allows the client who has the ability to authorize certain activities such as filing of patent applications (i.e, Ashby discloses workflow rules on a server system which, upon receiving a signal, generates a message that request approval and routes the message to a second client based on routing information defined in the workflow rule) ;

**storing a first invention disclosure/draft patent application in a database accessible by said server system** (Figure 9 Project Type Patent Application; 13-15); receiving, at said server system, a first signal from a first client system indicating a request to submit said first invention disclosure/ draft patent application for approval/ solicitation of comments (Figures 13-16 Client project approval; col. 4, lines 53-55 an approval structure 68 allows the client who has the ability to authorized certain activities such as the filing of patent applications in specific countries; col. 8, line 9 thru col. 9, lines 6 the example given herein describe projects related to managing intellectual property including filing documents with the US Patent and Trademark Office (PTO).

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**executing said first workflow rule from said server system to generate a message requesting approval to prepare a patent application from said invention disclosure/comments from a second client system and to communicate said message to said second client system** (col. 8, line 9 thru col. 9, line 6 Figs. 13-14 shows project manager screens 340 and 350 related to patent applications. In screen 340, client can approve filing a patent cooperation treaty; Fig. 15 shows a project related to a patent application and all the documents that are part of the file).

While Ashby discloses a project docket management apparatus with a notification structure and approval structure wherein the project is related to patent applications and that the approval notification relates to the patent application, Ashby does not disclose that the approval notification is a request for approval to submit an invention disclosure/draft patent application or a request for solicitation of comments. Ashby does not disclose tracking a time elapsed from receipt of the first signal indicating a request for approval and a time elapsed from communicating said message to said second client system.

Microsoft discloses that Tracking the Progress of Your Project (page 121) which tracks task duration (page 123). Furthermore, the Examiner takes Official Notice that Program Evaluation and Review Techniques (PERT) is an old and well known concept (developed in the 1950's) for analyzing tasks involved in completing a given project, especially the time needed to complete each task with charts of timelines that interconnect as is evidenced by the Program Evaluation and Review Technique from Wikipeda.org.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into Ashby the tracking disclosed in both Microsoft and Wikipedia since tracking progress allows one to identify and solve problems as they occur, produce reports for management and project participants, and plan future projects more accurately.

While Ashby stores case-related documents relating to patent applications, Ashby's approval notifications do not specifically contain a message requesting an approval to submit an invention disclosure or solicit comments. However, the differences in the types of documents of data in the messages are only found in the non-functional descriptive material which is not functionally involved in the steps recited not does this data alter the recited structural elements of the system. Therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Furthermore, the structural elements remain the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3e 1579, 32 USPQ2nd 1031 (Fed. Cir. 1994); MPEP 2106. Nevertheless, Ashby discloses a docket management method and system that stores patent application documents. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Ashby such that the one or more documents are invention disclosures and the message in the notification requesting approval is directed to a



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request to submit an invention disclosure or solicit comments in order to facilitate more efficient and rapid collaboration among various parties in an effort to transact a patent application.

Referring to Claims 11-12:

Ashby discloses wherein said message includes a links to electronic document relevant to said patent application (col. 9, lines 7-26).

Referring to Claim 16:

Ashby discloses wherein said processor is operative with said program to further allow said third client system to store a patent application corresponding to said invention disclosure in said database and, in response to selection of a submit icon, submit electronically submit said patent application to an patent office (col. 9, lines 27-33).

Referring to Claim 17:

Ashby discloses wherein said server system receives communications from said first client system, said second client system and said third client system over the Internet (col. 8, lines 54-56).

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4. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby and Microsoft as applied to claim 1 above, and further in view of Serbinis et al (US 6,584,466) (hereinafter referred to as Serbinis).

Referring to Claim 2:

Ashby discloses wherein said message is an alert requesting approval of an action (col. 3, line 61 thru col. 4, line 4 notification structure, client is notified of request for approval; col. 12, lines 47-54 Figure 12 shows a project manager screen 330 related to a trademark application. Screen 330 includes a section 332 that identifies actions needing approval of the client. In this case, the client is asked whether to approve a renewal. If client approves.... )

Ashby discloses a docket management apparatus and method wherein the projects are related to managing intellectual property (col. 8, lines 10-26). Ashby does not explicitly disclose storing the selection in the database. However, Serbinis discloses an Internet document management system and method that enable the transaction logging (col. 2, lines 32-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the docket management method and system of Ashby the transaction logging taught in Serbinis so that in a multi-user collaborative electronic document manipulation, revisions to a document may be tracked.

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Referring to Claim 3:

Ashby (disclosing patent applications) in combination with Serbinis disclose wherein if said second client system selects to approve preparation of the document, the server system generates a second message (col. 10, lines 23-44).

Referring to Claim 4:

Ashby (disclosing the user being a patent attorney (col. 8, lines 27-33) in combination with Serbinis disclose wherein said second message is communicated to a third client system (col. 10, lines 23-44). While Ashby discloses the user being a patent attorney, the fact that the system is associated with a patent law firm does not patentably distinguish the applicant's invention from the prior art. A system is a system, no matter whose office it is located in. Thus, this limitation is given little patentable weight.

Referring to Claim 5:

Serbinis discloses wherein said server system includes an access management system that assigns client systems to one or more user groups and assigns data and documents stored in said database to one or more user groups, and wherein said access management system allows a client system connected to said server system to access data and/or documents if the client system is assigned to the same group as the data and/or document (col. 6, lines 34-45; col. 9, lines 19-32).

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5. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby, Microsoft and Serbinis as applied to claim 5 above, and further in view of Takano et al (6,434,580) (hereinafter referred to as Takano).

Referring to Claim 6:

Ashby, Microsoft and Serbinis disclose the method of claim 5. Serbinis discloses levels of access-control protocols so that specific users' privileges with respect to a document are defined (col. 2, lines 38-43).

Ashby, Microsoft and Serbinis do not disclose wherein said first and second client systems are associated with a first technology developer and assigned by said server system to a first user group; said invention disclosure is part of a Case Data Unit assigned to said first user group; said third client system is assigned to a second user group different from said first user group; and, in response to said second client system approving preparation of said patent application, said server system also assigns said invention disclosure to said second group.

Takano discloses wherein the first and second client systems are associated with a first technology developer and assigned by the server system to a first user group (col. 1, lines 8-17 *a method and system for preparing patent specifications with inventors and persons in charge of filing patent applications **using a plurality of computers connected to a communication network**, such as the Internet, for preparing patent specifications for patent applications; col. 5, lines 55-61 the draft preparation means 101 is used by an employee or the like of a company (hereinafter referred to as an inventor) to report on an invention by the inventor as part of his or her*

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*duty in the company to department of the company responsible for patent application processing), said invention disclosure is part of a Case Data Unit assigned to the first user group (col. 8, lines 14-20 **displays on a display unit (not shown) a list of all the pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department])**), the third client system is assigned to a second user group different from the first user group (col. 6, lines 5-15 *the client computer 200 is used by a person of the patent application processing department of a company or a person of a patent attorney's office requested by the company to file a patent application*) and in response to the second client system approving preparation of the patent application the server system also assigns the invention disclosure to the second group (Figures 3-5, 14, 17 and col. 3, line 32 thru col. 4, line 55; See col. 7, line 54 thru col. 24 - Referring to FIG. 4, the table 304 consists of a plurality of entries for registering plural pieces of invention report information, and each entry consists of fields 21 to 26 in which items constituting **a piece of invention report information including a reference number, the title of the invention, the inventor's name, his or her employee ID number, assigned department and telephone numbers** are registered, a field 27 in which the storage address of draft data pertaining to that particular piece of invention report information in the specification file 303 is registered. Another specific example of registration processing at step A8 is conceivable, in which a piece of invention report information and draft data are put together and stored into a single directory (file), and this file, to*

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*which a directory (file) name enabling both the inventor using the client computer 100 and the patent-application-filing persons using the client computer 200 to identify the draft data, e.g. the reference number contained in the pertinent piece of invention report information, is assigned, is registered in the specification file 303. **Upon registration of the draft data for the specification for patent application and the pertinent piece of invention report information into the server computer 300 as described above, the patent-application-filing persons are enabled to revise the draft data on the client computer 200.** When the draft is to be revised, first the draft downloading means 201 of the computer 200 references the specification file management table 304 in the specification file 303 of the server computer 300; **displays on a display unit (not shown) a list of all the pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department])** (step A9); lets the patent-application-filing persons select a desired piece of invention report information; finds the storage address of the draft data pertaining to the selected piece of invention report information from the specification file management table 304; and reads the draft data from the specification file 303 on the basis of that address (step A10).*

It would have been obvious to one of ordinary skill in the art to combine the patent application project docket management apparatus method of Ashby and Microsoft and the access controls set forth in Serbinis with the technology developer

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and user groups of Takano so that inventors and persons in charge of filing patent applications using a plurality of computers connected to a communication network, such as the Internet, can prepare patent specifications for patent applications while allowing access to only those users satisfying specific conditions or inventors belonging to a specific department.

Referring to Claim 7:

Serbinis discloses workflow rules (*Figure 2, (61) and col. 6, lines 19-46*

*Referring to FIG. 2, DMS database 25 is described in greater detail.*

*Database 25 includes a plurality of tables 61-64 and 66-68 that maintain information on documents stored in store 30. Each of tables 61-64 and 66-68 may in turn consist of multiple tables. Document information tables 61 have entries for a number of document-related parameters, including: information on a document's parent document group; information on the document instances; information on the transport method to be used for retrieval of a document instance; information on the priority of the document; expiration information: the date and time when a document instance is changed from "active" status to "archived" status; **workflow information for a document instance; security information; document rights; and document group rights.** User information tables 62 have entries for information relating to users registered to access and use the DMS system, including: the name of the user; logon information for the user, e.g., user ID and password; user notification information, e.g., notification address and transport type; billing code information; information on the user's account, where each user*

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*account is unique to a service account and user; user session information; and user group information, i.e., information on the group of users that the user is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group).*

Serbinis discloses user group information. Serbinis does not disclose that the rules are associated with a technology developer.

However, Takano discloses the association with the technology developer (Figure 3 and col. 7, lines 11-27, Figure 4 and col. 7, line 52 thru col. 8, line 24 displays on a display unit a list of all the pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department]; col. 10, lines 8-29).

Referring to Claim 8:

Takano discloses wherein the client system sends a signal to the server system over the Internet (col. 1, lines 8-18 program for preparing patent specifications with inventors and persons in charge of filing patent applications using a plurality of computers connected to a communication network, such as Internet; col. 7, lines 27-34 transmits them, together with the piece of invention report information on the draft data to the server computer).

Referring to Claim 9:

Takano discloses wherein the first client system uploads the invention disclosure to the server system as part of the submission process (col. 7, lines 27-34 draft uploading means; transmits draft data to the server computer).



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Referring to Claim 10:

Takano discloses wherein the first client system creates the invention disclosure under the guidance of pages generated by the system (col. 6, line 44 thru col. 7, line 26 input screen; col. 7, line 52 thru col. 8, line 6; col. 9, lines 14-21 template data).

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby and Serbinis as applied to claim 14 above, and further in view of Gross et al (US 6,918,082) (hereinafter referred to as Gross).

Ashby discloses the Internet (col. 5, lines 54-56).

Ashby does not disclose a local area network.

However, Gross discloses wherein said first client system and second client system are coupled over a local or wide area network (col. 9, lines 16-24).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate a wide variety of networks as disclosed in Gross so as to provide a way to automatically display or track multiple versions of electronic documents for review and comments while simultaneously managing multiple different projects and documents with greater ease and greater access to participants.

***Response to Arguments***

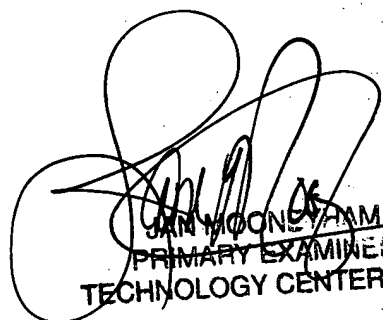
7. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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